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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,660	02/15/2002	Robert Lance Cook	25791.76	9727
27683	7590	12/14/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			CHAMBERS, A MICHAEL	
			ART UNIT	PAPER NUMBER
			3753	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/076,660	Applicant(s) COOK ET AL.	
	Examiner A. Michael Chambers	Art Unit 3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 4, 2005 and September 15, 2005...
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7 and 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 and 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/30/05</u> !) | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is further in response to an amendment filed August 4, 2005 and September 15, 2005. A compliant amendment has been filed in response to the Notice of Non-Compliant Amendment filed September 2, 2005. Claim 19 has been amended to correct a punctuation error. This action is further in response to a preliminary amendment filed February 15, 2002. Claims 1-6 and 8-16 have been canceled. In the preliminary amendment filed February 15, 2002, applicants discuss a restriction requirement which includes inventions I-XI and state that the present invention claims are "...generally directed to the invention of group X...". To expedite prosecution of the instant application, applicants are asked to provide a copy of that restriction requirement in response to this Office action. Applicants state that informational disclosure Statements (7) have been filed February 15, 2002, May 31, 2002, April 4, 2003, April 7, 2003, May 31, 2003 (2 IDS), August 2, 2004 and January 25, 2005. In view of the extensive number of citations and the number of copending and/or related applications cited in the specification, applicants are asked to provide a discussion of the prior art deemed most relevant to the elected invention of Group X. It should be noted that even applicants do not know the complete list of IDS filed. For example, IDS filed August 30, 2005 (4) October 31, 2003 (2) have been filed, however, not acknowledged by applicants in the amendment filed August 4, 2005. IDS stated by applicants to have been filed May 31, 2003, has NOT been received. Further a number of IDS have been filed on the dates listed above and not just a single filing. For example, January 25, 2005 (2 IDS; a number of 1449's). Applicants' statement that they decline to discuss relevant prior art of the invention X in view of their statement that it is "...generally directed to the invention of group X..." and even their not knowing what prior art

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statements have been filed in the instant application is not understood. Applicants' are asked to reconsider their statement on page 19 with regard to duty of disclosure under 37 C.F.R. 1.56. Consideration of the IDS which comply with 37 CFR 1.97 and 1.98 will be made when the above issues are reconsidered by applicants. Applicants updating of the status of pending applications (Patent numbers 6,568,471; 6,328,113; 6,497,289; 6,823,937, 6,575,240 and serial number 09/510,913) cited in the instant application specification is noted. Applicants are continue to maintain a clear line of demarcation between the subject matter of applicants' prior patents/application and the instant application. Claims 7 and 17-30 are pending. In view of the cancellation of claims drawn to the remaining inventions ten inventions, the restriction is made FINAL. An action on the merits of method claims 7 and 17-30 (dependent thereon and independent claim 30) is again included in this Office action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

5. Claims 7 and 17-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stout et al (Figure 4A). Note the disclosure of a “ball plug” 38 which when disposed on seat 40 in the inlet of the “apparatus for controlling the flow of fluidic materials” blocks the inlet of the throat passage to allow injected fluid pressure in tubing chamber to increase (column 5, lines 1+) and control piston. A screen 44 to control debris is disclosed. Predetermined hydraulic actuation pressures (which would be within the ranges recited) are disclosed in column 8, lines 21+. The passage in the apparatus is blocked and unblocked in response to shearing of the “piston” 90 “shear pin” 136. The rate would be controlled by the characteristics of the shear pin selected. It would have been obvious to one of ordinary skill in the art to operate the apparatus of Stout et al by the recited method steps. Contrary to applicants’ remarks the “...opening of the outlet passage...” occurs when the “shear pin” 136 breaks and the passage 134 allows fluid communication from the inlet to the outlet (i.e., opening an outlet passage). With regard to remarks drawn to claim 30, as above, the pressure required for actuation is a function of the shear pin selected which is deemed design choice. Stout et al discuss such design choice in column 8, lines 35+.

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Michael Chambers whose telephone number is 571-272-4908. The examiner can normally be reached on Mon-Thur. 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on 571-272-4930. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A. Michael Chambers
Primary Examiner
Art Unit 3753

amc
December 10, 2005